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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WOO, ISAAC M

ART UNIT PAPER NUMBER

2172

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,397

Applicant(s)

BOYER ET AL.

Examiner

Isaac M Woo

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to Applicant's amendment, filed on November 06, 2002 have been fully considered. The applicant amended claims 1, 7, 10, 16, 19, and 25. The pending claims are 1-27.

2. The objection to the specification (abstract) has been withdrawn because of the amendment.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette (U.S. Patent No. 5,991,751, hereinafter, "Rivette").

With respect to claims 1, 10 and 19, Rivette discloses the method, computer program and system for determining potential licensees for a source patent portfolio comprising one or more patents,

devising a set of associated patents wherein each patent in the set of associated patents i) cites as reference a patent in the source patent portfolio (forward reference, col. 4, lines 13-21, FIG. 86-90, and col. 89, lines 15-53) or ii) is cited as reference by a patent in the source patent portfolio (backward reference, col. 4, lines 13-21, FIG. 86-90, col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73);

processing all of the patents in the set of associated patents to establish a set of assignees contained in the set of associated patents (assignees searching), see (FIG. 53, col. 28, lines 1-51 and col. 93, lines 21-65). Rivette does not explicitly disclose the establishing a set of remaining assignees by removing from the set of assignees all assignees that are currently licensed, and organizing the set of remaining assignees according to a ranking criteria. However, Rivette discloses the set of assignees by searching assignee, see (FIG. 53, col. 28, lines 1-51 and col. 93, lines 21-65). And Rivette discloses the processing information of licensing information (214, FIG. 2) and the seventh information group includes licensed patents, see (Fig. 2, col. 11, lines 22-67 to col. 12, lines 1-33) on database for licenses, see (col. 16, lines 30-39, col. 18, lines 11-26) and also discloses the database provide the status of current licenses, see (col. 19, lines 3-15), which teaches that the system of Rivetts provide the assignees' license status using searching module (col. 26, lines 39-49) for a set of patent assignees status for licensing of patents, see (FIG. 86, col. 88, lines 22-64). Thus, Rivette can establish a set of patent related to patent licenses for either licensed or un-licensed by user's selection. Rivette discloses the searching and displaying by a sorting order that include descending order or ascending order, etc., (col. 28, lines 14-50, col. 91, lines 17-50),

which teaches when a user select either, un-licensed or licensed for sorting input attributes, then the system can display sorted order list (ranking criteria). Therefore, it would have been obvious a person having ordinary skill in the art the time invention was made to include establishing a set of remaining assignees by removing from the set of assignees all assignees that are currently licensed, and organizing the set of remaining assignees according to a ranking criteria in the system of Rivette to get licensed assignee's ranking list. Getting un-licensed assignees list results from searching by unlicensed assignee and displaying them by sorting order (ranking criteria) can provide information to a user for un-licensed assignees that may be potential licenses of patents, which provides useful information for business-related decision making.

With respect to claim 2, 11 and 20, Rivette discloses the adding, to the set of associated patents, patents that cite as a reference patents in the original set of associated patents (forward, col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53) or patents that are cited as a reference by a patent in the original set of associated patents, see (backward, col. 4, lines 13-21, FIG. 86, col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73).

With respect to claims 3, 12 and 21, Rivette discloses the determining a set of cited references contained in the patents of the source patent portfolio (forwarding references and backward references); adding, to the set of associated patents, patents that contain at least one of the references found in the set of cited references (reference

cited), see (col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53; col. 4, lines 13-21; FIG. 86; col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and FIG. 71-73).

With respect to claims 4, 13 and 22, Rivette disclose that the source portfolio (forwarding references) is the set of all patents assigned to a particular assignee, see (FIG. 53, col. col. 28, lines 1-51).

With respect to claims 5, 14 and 23, Rivette disclose that presenting the organized assignees in an HTML document that can be read by an Internet browser, see (FIG. 53, col. 10, lines 30-54, col. col. 28, lines 1-51 and col. 38, lines 25-67 to col. 39, lines 1-13).

With respect to claims 6-7, 15-16 and 24-25, Rivette discloses that the ranking criteria is the frequency of occurrence for each assignee in the set of associated patents (the combined referenced patents with forward references and backward referenced with specific assignee, col. 4, lines 13-21, FIG. 86-90, and col. 89, lines 15-53 and col. 4, lines 13-21, FIG. 86-90, col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14, FIG. 71-73, thus, user can easily identified the number of which assignee (frequency of occurrence) are on the list), and the ranking criteria expressed as a ratio of the total number of patents held by an assigned to the total number of patents held by that assignee in the set of associated patents, see (col.103, lines 59-67 to col. 1-18, Note: expression of numbers as a ratio (the number of degree results from number division)

is one of different mathematical manipulation, i.e., many different mathematical manipulation to express as different ratio differs with different number inputting attributes, definition of ratio: from mathematics, a fractional number represented as n/d , where n and d are integers, n is the numerator and d is the denominator).

With respect to claims 8, 17 and 26, Rivette discloses that the ranking criteria gives more weight to assignees having patents that have commonly cited references with patents in the source patent portfolio, see (col. 103, lines 25-67 to col. 104, lines 1-45).

With respect to claims 9, 18 and 27, Rivette discloses that the ranking criteria gives more weight to assignees both i) having patents that have a reference to a patent in the source patent portfolio (forward reference, col. 4, lines 13-21, FIG. 87 and col. 89, lines 15-53) and ii) having patents that are cited as a reference by a patent in the source patent portfolio, see (backward reference, col. 4, lines 13-21; FIG. 86; col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14 and col. 103, lines 25-67 to col. 104, lines 1-45).

Response to Arguments

In response to Applicant's remark filed on November 06, 2002, the following factual arguments are noted:

a. Rivette does not disclose or suggest the establishing a set of unlicensed assignees and organizing assignees according to a ranking criteria.

b. Rivette does not disclose or suggest the frequency occurrence for each assignee in the set of associated, and the ratio of total number of patents held by an assignee to the number of patents held by that assignees in the set of associated patents as ranking criteria.

In considering a, Rievetts discloses the searching module for licensing information for certain assignee, which can provide to establish unlicensed assignees list by disclosing from a set of assignees by searching assignee, see (FIG. 53, col. 28, lines 1-51 and col. 93, lines 21-65), the processing information of licensing information (214, FIG. 2) and the seventh information group includes licensed patents, see (Fig. 2, col. 11, lines 22-67 to col. 12, lines 1-33) on database for licenses, see (col. 16, lines 30-39, col. 18, lines 11-26), the database with the status of current licenses, see (col. 19, lines 3-15), which teaches that the system of Rivetts provide the assignees' license status using searching module (col. 26, lines 39-49) for a set of patent assignees status for licensing of patents, see (FIG. 86, col. 88, lines 22-64). Thus, Rivette can establish a set of patent related to patent licenses for either licensed or un-licensed by user's selection. And Rivette discloses the displaying the results of searching with sorting by

descending order or ascending order, which describes the displaying a searching result list with certain ranking (FIG. 60) by descending order or ascending order or etc. Thus, Rivette can display list with ranking criteria.

In considering b, first of all, ratio represented as number is one of mathematical manipulation with using different input attributes for numerator and denominator. Thus, ratio of total number of patents held by an assignee to the number of patents held by that assignees in the set of associated patents, are considered merely as mathematical manipulation. In addition to, Rievetts discloses searching by assignee, which can provides the occurrences of assignee, see (FIG. 53, FIG. 57, FIG. 60-61, col. 28, lines 1-51 and col. 93, lines 21-65). And Rievetts discloses a set of associated patents that is collection of patents in the source patent portfolio (forward reference, col. 4, lines 13-21, FIG. 86-90, and col. 89, lines 15-53, backward reference, col. 4, lines 13-21, FIG. 86-90, col. 87, lines 16-67 to col. 88, lines 1-67 to col. 89, lines 1-14, FIG. 71-73). For example, from the FIG. 53, user can type IBM to get total patent numbers for IBM on field of 5312, then result will be shown on field 5332, FIG. 53 (getting total number of patent held by IBM) and user can get number of assignees (IBM) on the a set of associated patents set forth above. Ratio is a fractional number n/d , where n and d are integers, n is the numerator and d is the denominator. Thus, user can easily identify the ratio of n/d , number of assignee on the set of associated patents divided by total number of patents for assignee.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brodersen et al (U.S. Pub. No. 2002/0029161) discloses the system for assigning resources to tasks in a rule based, resource constrained system. This is done by receiving as inputs tasks and task attributes; resources and resource attributes; and assignment rules. These inputs are used to searching a database of tasks, task attributes, and assignment rules thereof, to search a database of resources including resource attributes thereof, and to retrieve resources based upon the resource attributes. Resources are assigned to tasks based upon matches and scores of the resource attributes, the task attributes, and the assignment rules.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (703) 305-0081. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

IMW
March 6, 2003


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